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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,167	10/17/2001	Chunhua Yan	CL001303	3910

25748 7590 06/12/2003

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EXAMINER	
STEADMAN, DAVID J	

ART UNIT	PAPER NUMBER
1652	

DATE MAILED: 06/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/978,167	YAN ET AL.	
	Examiner	Art Unit	
	David J. Steadman	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Application Status

[1] Claims 1-23 are pending in the application.

Election/Restrictions

[2] Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claim(s) 1, 2, 20, and 21, drawn to an isolated peptide, classified in class 530, subclass 350.

II. Claim(s) 3, drawn to an isolated antibody, classified in class 530, subclass 387.9.

III. Claim(s) 4-6, 8-11, 22, and 23, drawn to an isolated nucleic acid, a gene chip comprising a nucleic acid, a vector comprising a nucleic acid, a host cell comprising said vector, and methods for producing polypeptides, classified in class 435, subclass 69.1.

IV. Claim(s) 7, drawn to a transgenic non-human animal comprising a nucleic acid, classified in class 800, subclass 13.

V. Claim(s) 12, drawn to a method for detecting the presence of a polypeptide, classified in class 435, subclass 7.1.

VI. Claim(s) 13, drawn to a method for detecting the presence of a nucleic acid, classified in class 435, subclass 6.

VII. Claim(s) 14-16, drawn to a method of identifying a modulator of or an agent that binds to a polypeptide, classified in class 435, subclass 7.1.

VIII. Claim(s) 17, drawn to a pharmaceutical composition comprising an agent that binds to a polypeptide, classified in class 514, subclass 789.

IX. Claim(s) 18, drawn to a method for treating a disease or condition mediated by a human secreted protein by administering an agent that binds to a polypeptide, classified in class 514, subclass 789.

X. Claim(s) 19, drawn to a method for identifying a modulator of the expression of a polypeptide, classified in class 435, subclass 7.1.

[3] The inventions are distinct, each from the other because:

[4] The peptide of Group I, the antibody of Group II, the polynucleotide of Group III, the transgenic non-human animal of Group IV, and the pharmaceutical composition of Group VIII each comprises a biologically and chemically unrelated structure capable of separate manufacture, use, and effect. The polynucleotide of Group III has other utility besides encoding polypeptides such as a hybridization probe, the peptide of Group I can be made by another method such as purification from the natural source or synthetically, the antibody of Group II can be made using a polypeptide other than the peptide of Group I, such as a polypeptide purified from the natural source or generated by synthetically, the transgenic non-human animal of Group IV can be used in the production of the polypeptide of Group II, and the pharmaceutical composition of Group VIII can be used as an affinity reagent for the purification of the peptide of Group I.

[5] The peptide of Group I is unrelated to the method(s) of Groups VI and IX as it is neither used nor made by the method(s) of Groups VI and IX.

[6] The peptide of Group I and the methods of Groups V, VII, and X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the peptide of Group I can be used for production of the antibody of Group II.

[7] The antibody of Group II is unrelated to the method(s) of Groups VI, VII, IX, and X as it is neither used nor made by the method(s) of Groups VI, VII, IX, and X.

[8] The antibody of Group II and method of Group V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product

as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Group II can be used as an affinity reagent for the purification of the peptide of Group I.

[9] The polynucleotide of Group III is unrelated to the method(s) of Groups V, VII, IX, and X as it is neither used nor made by the method(s) of Groups V, VII, IX, and X.

[10] The polynucleotide of Group III and the method of Group VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotide of Group III can be used for the production of the polypeptide of Group I.

[11] The transgenic non-human animal of Group IV is unrelated to the method(s) of Groups V-VII, IX, and X as it is neither used nor made by the method(s) of Groups V-VII, IX, and X.

[12] The pharmaceutical composition of Group VIII is unrelated to the method(s) of Groups V-VII and X as it is neither used nor made by the method(s) of Groups V-VII and X.

[13] The pharmaceutical composition of Group VIII and the method of Group IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the pharmaceutical composition of Group VIII can be used as an affinity reagent for the purification of the polypeptide of Group I.

[14] The methods of Groups V-VII, IX, and X are independent as they comprise different steps, utilize different products, and yield different results.

[15] MPEP § 803 sets forth two criteria for restricting between patentably distinct inventions – 1) the inventions must be independent or distinct and 2) there must be a serious burden on the examiner. MPEP § 803 states, "For purposes of the initial requirement, a serious burden on the examiner may be *prima*

facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02". Because the inventions of Groups I-X are distinct for the reasons given above, have separate classification and/or each of the inventions requires a separate patent and non-patent literature and/or sequence search, restriction for examination purposes is proper.

[16] Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

[17] Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Thursday from 6:30 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for this Group is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.
Patent Examiner
Art Unit 1652

06/09/03